

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 08203.0031-00000	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on _____  Signature _____  Typed or printed name _____	Application Number 10/635,910	Filed August 7, 2003	
	First Named Inventor John BUTLER		
	Art Unit 3775	Examiner Andrew YANG	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor. _____ Signature /Hojung Cho/</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. _____ Hojung Cho Typed or printed name</p> <p><input type="checkbox"/> attorney or agent of record. Registration number _____ (202) 408-4000 Telephone number</p> <p><input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 <u>Ltd. Rec. No. L0596</u> _____ March 30, 2011 Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			

☒ \*Total of one (1) form is submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

*If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.*

Applicant requests a pre-appeal brief review of the rejections set forth in the Office Action mailed September 30, 2010 ("the Office Action").

**Rejection Under 35 U.S.C. § 112, first paragraph**

Applicant respectfully requests withdrawal of the rejection of claims 106, 108, and 112 under 35 U.S.C. § 112, first paragraph. The Office Action asserts that the disclosure does not state or imply "a sum of the diameters of at least two of the accessways is greater than the radius of the sealing member," and asserts that the disclosure does not state the figures are to scale. Office Action at 2-3. The Office Action also asserts that the specification does not disclose, and figures fails to show, that "the axes of the two accessways intersect proximate an axis of the sealing member," as recited in claim 108. *Id.* Applicant respectfully disagrees.

Regarding the written description requirement, "[t]he fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that...applicant was in possession of the invention now claimed." M.P.E.P. § 2163 (8<sup>th</sup> ed. Rev. 5, August 2006). "Drawings alone may be sufficient to provide the written description of the invention required by §112, first paragraph." *Vas-Cath, Inc.*, 935 F.2d at 1565, 19 USPQ2d at 1117.

The disclosure of, for example, Fig. 33, establishes adequate support for the recitations of "a sum of the diameters of at least two of the accessways [being] greater than the radius of the sealing member," as set forth in claims 106 and 112. Applicant submits that the relative position and sizes of the features within the device shown in the planar view of Fig. 33 are depicted in such a manner as to convey to one of ordinary skill in the art that the applicant was in possession of this claimed feature. Applicants are not

deriving actual measurements from the drawings, but merely the general relative sizes of the depicted features.

Similarly, the disclosure of, for example, Figs. 34 and 35, clearly establishes adequate support for the recitations of “the axes of the two accessways intersect proximate an axis of the sealing member,” as set forth in claims 108. Although such axes are not expressly shown in the drawings, the drawings convey with reasonable clarity to those skilled in the art that the Applicant was in possession of the feature that “the axes of the two accessways intersect proximate an axis of the sealing member.”

Applicant submits that the support for the claimed features is express, and if not express, then at least implicit or inherent, in the originally filed application. Therefore, the originally filed application clearly allows a person of ordinary skill in the art to recognize that Applicant has invented what is claimed in claims 106, 108, and 112, and these claims are in compliance with the written description requirement. See M.P.E.P. § 2163.02. Accordingly, the § 112, first paragraph, rejections are improper and should be withdrawn.

**Rejection Under 35 U.S.C. § 103(a) Based On Fadem and Beane**

Applicant respectfully requests withdrawal of the rejection of claims 104, 105, 107, and 108 under 35 U.S.C. § 103(a) based on U.S. Patent No. 6,254,533 to Fadem et al. (“Fadem”) in view of U.S. Patent No. 5,590,657 to Beane (“Beane”). Independent claim 104 recites, *inter alia*, “a sealing member . . . including a dome shape when in use, and at least three accessways on the dome shape . . . axes of at least two of the accessways converging to a point, the point being located below a circumferential extent of the sealing member.”

Neither Fadem nor Beane teaches the above-quoted features of claim 104. While Fadem teaches dome 108, Fadem does not teach at least three accessways on dome 108. See Fadem at FIG. 4. Even if, *arguendo*, dome 108 of Fadem could be modified to include a plurality of access openings as disclosed in Beane (as suggested on page 4 of the Office Action), and Applicant does not agree that it can, neither Fadem nor Beane discloses or suggests that “axes of at least two of the accessways converging to a point, the point being located below a circumferential extent of the sealing member,” as recited in claim 104.

In the Office Action, the Examiner asserted that “the location of the point is a function of where the center of each accessway is arranged on the dome. The Applicant has not disclosed any particular benefit of such a configuration, therefore, it would have been obvious . . . to construct the device of Fadem et al. as modified by Beane et al. with the accessways arranged so that the axes of at least two accessways converge at a point below the circumferential extent of the sealing member since it has been held that rearranging parts of an invention involves only routine skill in the art.” Office Action at 5. On the contrary, in the Amendment filed March 15, 2010, the Applicant disclosed numerous advantages resulting from the above-quoted features, in particular:

putting accessways 136 and 137 on the dome shape of sealing member 132, with axes of accessways 136 and 137 converging to a point located below a circumferential extent of sealing member 132, assists with triangulation of instruments by allowing distal portions of instruments inserted through accessways 136 and 137 to be naturally guided toward each another within the body cavity. Such triangulation assists in aligning multiple instruments within the incision. In addition, proximal portions of the instruments that remain outside of accessways 136 and 137 may be guided away from each other, creating more space for movement of the proximal portions of the instruments above sealing member 132. Further, the arrangement of accessways 136 and 137 on the dome shape, with their axes converging, may also help guide objects inserted through accessways 136 and 137 away

from the edges of the wound opening, thus reducing contact with the edges of the wound opening, and making procedures less traumatic.

March 15, 2010 Amendment, page 15. Based on these advantages, a rejection based on a conclusory “rearranging parts” rational is improper and should be withdrawn. Further, in response to this rejection, Applicant provided the “particular benefit” stated as missing, and yet the rejection has been maintained. For this additional reason, the rejection should be withdrawn. For at least the foregoing reasons, claim 104 is allowable over the cited references. Claims 105-108 depend from claim 104 and are therefore allowable for at least the same reasons that claim 104 is allowable.

**Rejection Under 35 U.S.C. § 103(a) Based On Fadem and Cuschieri**

Applicant reserves the right to argue the rejection of independent claim 109 in a future reply to the Office. Nonetheless, Applicant submits that the rejection of dependent claims 110 and 111 warrants pre-appeal brief review. Applicant respectfully requests withdrawal of the rejection of claims 110 and 111 under 35 U.S.C. § 103(a) based on Fadem in view of U.S. Patent No. 5,480,410 to Cuschieri et al. (“Cuschieri”). Claim 110 recites, *inter alia*, that “at least three accessways are positioned on the dome shape such that axes of at least two of the accessways converge toward one another as the axes extend distally through the proximal ring,” and claim 111 depends from claim 110 and further recites that “the axes of at least two of the accessways converge to a point underneath the sealing member.” Neither Fadem nor Cuschieri discloses or suggests that the above-quoted features of claims 110 and 111.

In the Office Action, the Examiner asserted that “the point at which the axes converge of at least two accessways on a dome shape is a function of where the accessways are arranged. As stated above, the Applicant has not disclosed any reasoning, benefit, or that

such a configuration solves any problems, the limitations of claims 110 and 11 are obvious to one skilled in the art since rearranging or parts in a device requires only routine skill in the art.” Office Action at 6. Applicant respectfully disagrees and points out that the Applicant already has disclosed numerous advantages resulting from the above-quoted features. For instance, in the present application, putting accessways 136 and 137 on the dome shape of sealing member 132, with axes of accessways 136 and 137 converge toward one another as the axes extend distally through the proximal ring 131, assists with triangulation of instruments by allowing distal portions of instruments inserted through accessways 136 and 137 to be naturally guided toward each another within the body cavity. Such triangulation assists in aligning multiple instruments within the incision. In addition, proximal portions of the instruments that remain outside of accessways 136 and 137 may be guided away from each other, creating more space for movement of the proximal portions of the instruments above sealing member 132. Further, the arrangement of accessways 136 and 137 on the dome shape, with their axes converging, may also help guide objects inserted through accessways 136 and 137 away from the edges of the wound opening, thus reducing contact with the edges of the wound opening, and making procedures less traumatic. See *also* March 15, 2010 Amendment, page 15. Thus, for the same reasons discussed above with respect to claim 104, the rejection based on a conclusory “rearranging parts” rational is improper. For at least this reason, claim 110 and 111 are allowable over the cited references and the outstanding rejection should be withdrawn.